

REMARKS

This communication is responsive to the Office Action mailed on June 9, 2004. Claim 16 is amended, no claims are canceled, and no claims are added. As a result, claims 1-27 are now pending in this Application. It is respectfully noted that claim 16 has been amended solely to correct typographical errors, and not for reasons related to patentability. If the Examiner is not convinced that the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action.

§102 Rejection of the Claims

Claims 1-6, 8-12, 13-17, 20-22, and 24-26 were rejected under 35 USC § 102(b) as being anticipated by Rosen et al. (U.S. 6,014,090, hereinafter "Rosen"). The Applicant does not admit that Rosen is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Applicant asserts that the Office has not shown that Rosen discloses the identical invention as claimed, the Applicant respectfully traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaa Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Regarding claims 1 and 13 (and claims 2-6, 8-12, and 14-15 depending from them), it is respectfully noted that Rosen does not disclose "a mobile element having a memory including a set of user service preferences," as claimed by the Applicant. First, no memory is shown or described with respect to Rosen's mobile communication system 130, 430. See Rosen, FIGs. 1 and 4; and associated text at Rosen, Col. 2, line 40 – Col. 4, line 43. Second, even if the

communication system 130, 430 did include a memory, as noted by Rosen in the text cited by the Office, "... the user's profile can be stored in memory 112 of resolution server 110." Rosen, Col. 5, line 67 – Col. 6, line 1. Thus, the user's profile is stored in the resolution server 110, and not in a memory of the mobile communication system 130.

Regarding claims 16, 20, and 25 (and claims 17, 21-22, 24, and 26 depending from them), it is respectfully noted that Rosen does not disclose "an application associated with the second service preference," or "selecting a second service preference associated with the application," as claimed by the Applicant. Considering the text in Rosen cited by the Office, it is respectfully suggested that perhaps the Office has confused the "application" claimed by the Applicant with either the "server address" or "information" taught by Rosen.

Rosen describes two scenarios for communicating with a mobile communication system. The first is shown in FIG. 2. At block 240 the method will "send at least one resource server address to telecommunication transceiver," after which, by selecting an address at the mobile system, the method will operate to "send geographically localized information" to the system. This is confirmed by the associated text of Rosen at Col. 6, lines 5-11 and 26-33. Neither the server address nor the user-readable information (which is "provided to the user from telecommunications transceiver 131 via user interface device 133) is an "application" or program to be executed by a computer. A similar process is documented in Rosen at FIG. 3. Again, server addresses are received, as well as user-readable information. See Rosen, Col. 6, line 66 – Col. 7, line 5 and Col. 7, lines 41-48. The Applicant was unable to find any teaching within the bounds of Rosen where applications (not addresses or information) were associated with service preferences.

It is respectfully noted that "[t]he *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added). Since Rosen does not teach "a mobile element having a memory including a set of user service preferences," or "an application associated with the second service preference," or "selecting a second service preference associated with the application," what is disclosed by Rosen is not identical to the subject matter of the embodiments claimed, and the rejection of claims 1-6, 8-12, 13-15, 16-17,

20-22, and 24-26 under § 102 is improper. Reconsideration and allowance are respectfully requested.

§103 Rejection of the Claims

Claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Rosen in view of Roundtree (U.S. 6,640,098, hereinafter "Roundtree"). Claims 18, 19, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Rosen in view of Bar et al. (U.S. 6,456,852, hereinafter "Bar"). First, the Applicant does not admit that Rosen, Roundtree, or Bar are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One

of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: First, with respect to independent claims 1, 16, 20 and 25, no combination suggested in the Office Action will render all of the claim limitations. As noted above, Rosen does not disclose “a mobile element having a memory including a set of user service preferences,” as claimed by the Applicant. Neither does Roundtree.

Roundtree, like Rosen, maintains preferences in a system server database, and not in the mobile device. See Roundtree, Col. 3, lines 64-66. Thus, independent claim 1 is nonobvious. This conclusion applies with even greater force respecting dependent claim 7, since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

Second, with respect to independent claims 16, 20, and 25, the Office admits that Rosen does not disclose a number of elements claimed by the Applicants, including “a memory for receiving a set of capabilities,” or “an application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements,” or “sending a set of capabilities associated with the mobile element to a service broadcaster,” or “refraining from broadcasting the application.” Other elements not present include “an application associated with the second service preference” and “selecting a

second service preference associated with the application according to the position". None of these elements are present in Bar.

It is asserted in the Office Action that Bar teaches "sending/broadcasting information to the user from a database depending on the capability associated with the user device" in Col. 5, lines 42-65 of Bar. However, a close reading of Bar reveals that this assertion is incorrect. In reality, Bar offers no choice at all: if the user has a laptop/modem, the user may access the database directly; otherwise, the user must dial a telephone number and listen to a series of recordings to obtain the desired information. Thus, Bar requires the user to determine capabilities and adjust his activity thereby; no "capabilities" are stored or used for comparison in Bar, as claimed by the Applicant. See Bar, Col. 5, lines 54-57. Thus, independent claims 16, 20, and 25 are nonobvious, as are those claims 18-19, 23, and 27 that depend from them.

No Motivation to Combine References: The Office asserts that one would be motivated to combine Rosen with Roundtree because "this arrangement would facilitate accessing information from the Internet." However, this assertion is incorrect. Rosen already provides access to the Internet via server addresses. For example, Rosen illustrates the direct conversion of a user location near a highway mile marker into a uniform resource locator World Wide Web address. See Rosen, Col. 5, lines 44-54. Nothing in the cited references indicates that adding the complexity of Roundtree to Rosen will further "facilitate access to the Internet" as asserted in the Office Action. Thus, there is no motivation to combine Rosen with Roundtree.

The Office further asserts that one would be motivated to combine Rosen with Bar because "this arrangement would provide flexibility to the user for receiving information from a server in a form suitable for the user device." However, this assertion is also incorrect. Rosen already provides flexible access to server addresses. For example, Rosen illustrates the provision of a number of server addresses based on user location. See Rosen, Col. 6, lines 5-11. As noted above, Bar merely offers the alternative of calling the server via telephone to listen to recorded messages. Nothing in the cited references indicates that adding this manual user activity offered by Bar to Rosen will provide "flexibility to the user for receiving information from the server" as asserted in the Office Action. In fact, Rosen teaches away from using the telephone, since even "[t]ravel agents cannot easily modify a traveler's travel plan where those travel plans rapidly change." Thus, there is no motivation to combine Rosen with Bar.

The use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

No Reasonable Expectation of Success: As has been previously noted, modifying Rosen to implement the access to the Internet provided by Roundtree may actually create additional barriers to access, rather than facilitating access. For example, Roundtree introduces a complex process whereby individual wireless devices are “pinged” before access may be granted, adding another layer of access delay. See Roundtree, FIG. 6, block 174 and associated text at Col. 9, line 49 – Col. 10, line 4.

In addition, as noted above, several elements of claims 18-19, 23, and 27 are not provided by any of the cited references. Thus, there is no reasonable expectation that any combination of Rosen, Roundtree, and Bar will be able to provide the missing elements, such as “sending” and “receiving” capabilities, and “refraining” from sending applications based on comparing capabilities. Further, none of the references discloses “an application associated with the second service preference” and “selecting a second service preference associated with the application according to the position”.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Therefore, since there is no evidence in the record to support disclosure by either Rosen, Roundtree, or Bar of “a mobile element having a memory including a set of user service preferences,” or “an application associated with the second service preference,” or “selecting a second service preference associated with the application according to the position,” or “a memory for receiving a set of capabilities,” or “an application is not downloaded to the mobile

element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements,” or “sending a set of capabilities associated with the mobile element to a service broadcaster,” or “refraining from broadcasting the application,” since there is no motivation to supply the missing elements (since the references teach away from such a combination), and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 20, and 25. This conclusion also applies to dependent claims 7, 18-19, 23, and 27 since any claim depending from a nonobvious independent claim is also nonobvious. It is therefore respectfully requested that the rejections of claims 7, 18-19, 23, and 27 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Mark Muller at 210-308-5677, or the below-signed attorney (at 612-349-9592), to facilitate prosecution of this Application. As noted above, if the Examiner is not convinced that the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9 day of August, 2004.

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